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OFFICE OF PETITIONS

In re Patent of
Allen
Patent No. 6,461,019
Application No. 09/819,736
Issued: October 8, 2002
Filed: March 29, 2001
Attorney Docket No. 05211.001

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: DECISION ON PETITION
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: UNDER 37 CFR 1.78(a)(3)
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This is a decision on the petitions under 37 CFR 1.78(a)(3), filed June 21, 2005 and April 26, 2006, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed nonprovisional applications set forth in the amendment filed concurrently with the instant petition. Petitioner requests correction via Certificate of Correction.

The petition is **DISMISSED**, without prejudice, as follows.

The present nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed nonprovisional applications is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Therefore, a petition under 37 CFR 1.78(a)(3), along with submission of a Certificate of Correction, is the appropriate avenue of relief to accept a late claim for the benefit of priority to a prior-filed nonprovisional application after issuance of the application into a patent. *See* MPEP § 1481.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application(s), unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was

The petition complies with items (2) and (3) above. The petition does not comply with item (1).

The correction of the references to the prior-filed applications that appears on the Certificate of Correction form (PTO/SB/44) is not acceptable as drafted since it improperly incorporates by reference prior-filed provisional application 60/119,804. An incorporation by reference statement added after an application's filing date is not effective because no new matter can be added to an application after its filing date (*see* 35 U.S.C. § 132(a)). If an incorporation by reference statement is included in an amendment to the specification to add a benefit claim under 35 U.S.C. § 120 after the filing date of the application, the amendment would not be proper. When a benefit claim under 35 U.S.C. § 120 is submitted after the filing of an application, the reference to the prior application cannot include an incorporation by reference statement of the prior application. *See Dart Industries v. Banner*, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980). *Note* MPEP §§ 201.06(c) and 608.04(b).

In light of the dismissal of the petition under 37 CFR 1.78(a)(3), it would not be appropriate to grant the requested certificate of correction. *See* MPEP § 1481.03.

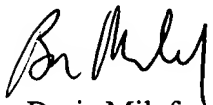
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Any questions concerning this matter may be directed to Legal Examiner George Dombroske at (571) 272-3283.



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